## REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed September 22, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### I.    Claim Rejections - 35 U.S.C. § 101

Claims 12-16 have been rejected under 35 U.S.C. § 101 as claiming non-statutory subject matter.

In response to the rejection, claims 12-16 have been amended to be drawn to a "computer readable medium" instead of a "program". In view of those amendments, Applicant respectfully submits that the rejection has been overcome, and requests that the rejection be withdrawn.

### II.    Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-3, 6-9, 11-14, and 16 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Hansen (U.S. Pat. No. 5,819,042). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the Hansen reference. Applicant discusses Applicant's claims and the Hansen reference in the following.

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## A.    The Hansen Disclosure

Hansen discloses a method for configuring (i.e., building) a network. As described by Hansen in column 2, lines 23-37:

> In one embodiment, the present invention is of an apparatus and associated method, implemented on a computer system, for constructing a configuration file for a network device. The apparatus includes a configuration script stored in a memory subsystem of the computer system and a software module executable by a processor subsystem of the computer system. The configuration script contains a series of executable instructions for constructing a configuration file for a first specified type of network device. By executing the instructions contained in the configuration script, the software module may construct a configuration file suitable for upload to a network device of the first specified type for configuration such that the network device may be configured using the configuration file constructed by the software module.

From the above, it can be appreciated that Hansen's system (or "network device configuration tool 10") is used to generate configuration files for the various devices that are to be added to a given network, such as a network that the user is administering at a given location.

In building the network, the network administrator first maps a representative network configuration using a graphical user interface (GUI) of the configuration tool. Once that representative network configuration is established, the network can be constructed by creating the network files that will be used to configure the devices for connection to the network under construction. As is described by Hansen in column 6, lines 23-30:

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The network administrator may then configure remotely located network devices by uploading configuration files constructed during the process of building the network configuration map to the devices. Thus, by using the network configuration tool, the network administrator can, from a central location, design a suitable configuration network and then configure any number of remotely located devices included in the network.

The process used to construct the configuration files that are to be uploaded to the various devices is described by Hansen in columns 13-15. As is described by Hansen in column 13, line 56 to column 14, line 3:

In turn, the execution of the script commands causes a series of questions to be asked of the network administrator, the answers to which are used to construct a configuration file. For example, if the script commands set forth in the guided configuration section of the configuration script set forth in Appendix A were executed during configuration of a Cisco 2514 router, the network administrator would be asked to name the router, indicate whether to configure internet protocol (or "IP") for the router, indicate which IP routing protocol should be used for the router, whether to configure IPX for the router, indicate whether the router should be password protected, choose a password for the router, indicate whether the configuration mode for the router should be password protected and choose a password for the configuration mode.

As can be appreciated from the above excerpt, the administrator is needed to provide various details as to the device configurations and communication protocols.

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**B. Applicant's Claims 1-3 and 6**

Independent claim 1 provides as follows (emphasis added):

1. A *method for providing a client on a remote client network access to a resource on a local network*, the method comprising:

providing a graphical user interface (GUI) to an operator with which client connectivity with the resource *on the local network* can be enabled, *the GUI being configured such that the process used by the operator to facilitate connectivity using the GUI is the same regardless of a configuration of the remote client network*;

receiving commands of the operator with the GUI that convey the identity of the client and the resource to be accessed by the client;

*automatically determining the client network configuration*; and

*automatically establishing client connectivity to the resource so as to provide the client on the remote client network access to the resource on the local network.*

1. **Providing a Client on a Remote Network Access to a Resource on a Local Network**

Regarding claim 1, Applicant reiterates that Applicant is claiming a <u>method for providing a remote client access to a resource on a local network</u>. It is clear from the foregoing description of the Hansen reference that Hansen does not teach such a method. Instead, as is discussed above, Hansen provides a system (or "configuration tool") that is used *to build a network*, not provide access for remote clients to resources on an existing local network. On this point, the Examiner states the following:

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In attempting, to overcome the preamble's [sic] argument, applicant includes "so as to provide the client on the remote network access to the resource on the local network", however, the added phase [sic] merely restates an intended use portion of the preamble in the body of the claim akin to using whereby or wherein clauses, which does not further limiting [sic] the claims.

As a first matter, Applicant again asserts that the preamble does not recite a mere "intended purpose," but actually states *what the invention is.* What the Examiner appears to be failing to grasp is that the claim in question is a *method* claim, not an apparatus claim. Therefore, when the preamble recites providing a client on a remote client network access to a resource on a local network, this is no intended purpose, but actually the method that is being explicitly described in the claim body. As is well-established in the law, such recitations *must* be considered when they give "life and meaning" to the claim terms in cases such as this in which the body of the claim relies on the preamble. *See, e.g., Catalina Marketing International, Inc. v. Coolsavings.com Inc.*, 289 F.3d 801, 62 USPQ2d 1781 (Fed. Cir. 2002) ("In general, a preamble limits the invention if it recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim"); *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 65 USPQ2d 1961 (Fed. Cir. 2003) ("preamble language will limit the claim if it recites not merely a context in which the invention may be used, but the essence of the invention without which performance of the recited steps is nothing but an academic exercise"). In the instant case, the preamble of claim 1 recites the "essence" of the invention, i.e., providing a remote client access to a resource on a local network. Moreover, the preamble gives life, meaning, and vitality to the limitations that follow in the body of the claim, which

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explicitly refer back to the preamble. Therefore, the Examiner's refusal to give weight to the phrase "providing a remote client access to a resource on a local network" is clearly improper.

Second, Applicant notes that the Examiner's statement of the effect of "whereby" and "wherein" clauses is clearly incorrect. The argument that such clauses per se do not further limit claims is a misstatement of the law. To the contrary, the courts have repeated held that "wherein" and "whereby" clauses, as well as similar clauses, cannot simply be disregarded. *See, e.g., Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 14 USPQ2d 1871 (Fed. Cir.), *cert. denied*, 502 U.S. 808 (1991); Griffin v. Bertina, 285 F.3d 1029, 62 USPQ2d 1431 (Fed. Cir. 2002).

In view of the foregoing, it is reversible error for the Examiner to continue to ignore the limitation "providing a client on a remote client network access to a resource on a local network" in the preamble of claim 1, or the limitation "establishing client connectivity to the resource so as to provide the client on the remote client network access to the resource on the local network" in the body of claim 1. Those recitations are explicit limitations that describe the claimed invention and, therefore, must be considered in formulating a rejection of Applicant's claim.

> 2.    **A GUI Configured such that the Process used by the Operator to Facilitate Connectivity using the GUI is the Same Regardless of a Configuration of the Remote Client Network and Determining the Client Network Configuration**

Because, as is described above, Hansen is not concerned about providing access for remote clients to resources on different networks, it logically follows that Hansen does not teach a GUI that is "configured such that the process used by the operator to facilitate connectivity using the GUI is the same regardless of a

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configuration of the remote client network" or "determining the client network configuration", as are required by claim 1. Specifically, if access is not to be provided to a device on a remote network, there is no need to provide a GUI that operates the same regardless as to network configuration, and no need to determine the configuration of the remote network. Moreover, the Office Action has yet to identify a GUI that is used in the Hansen system, much less a GUI that "is the same regardless of a configuration of the remote client network". Applicant notes that these are explicit limitations of the claim that must be considered in evaluating the patentability of Applicant's claims.

### 3. Automatically Establishing Client Connectivity to the Resource

As was also noted in Applicant's previous Response, Hansen does not teach "*automatically* establishing client connectivity to the resource". Although Hansen describes a process through which two devices are connected within a network, Hansen does *not* describe an automated process. Instead, as is discussed above, active participation from the network administrator is required. Applicant notes that the Examiner ignored this point in the previous rejection, and further has yet to address this issue to date.

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### 4.    Conclusion

In view of the above, Hansen fails to anticipate several of the limitations of Applicant's claim 1, and therefore the claims that depend therefrom.   Applicant respectfully requests that the rejection be withdrawn.


### C.    Applicant's Claims 7-9 and 10-11

Independent claim 7 provides as follows (emphasis added):


7.    A *system for providing a client on a remote client network access to a resource on a local  network*, the system comprising:

means for providing a graphical user interface (GUI) to an operator with which client connectivity with the resource *on the local network* can be enabled, *the GUI being configured such that the process used by the operator to facilitate connectivity using the GUI is the same regardless of a configuration of the remote network*;

means for receiving commands of the operator with the GUI that convey the identity of the client and the resource to be accessed by the client;

*means for automatically determining the client network configuration*; and

*means for automatically establishing client connectivity to the resource so as to provide the client on the remote client network access to the resource on the local network.*


Regarding claim 7, Hansen does not teach or suggest a "system for providing a client on a remote client network access to a resource on a local network" that includes a GUI that is "configured such that the process used by the operator to facilitate connectivity using the GUI is the same regardless of a configuration of the remote

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network", for reasons described above in relation to claim 1. Moreover, Hansen fails to teach or suggest "means for *automatically* determining the client network configuration" or "means for *automatically* establishing client connectivity to the resource", also for reasons discussed in relation to claim 1.

In view of the above, Applicant respectfully submits that Hansen does not anticipate claim 7, or claims 8-9 and 10-11 that depend from claim 7. Applicant therefore requests that the rejection be withdrawn.


### D.    Applicant's Claims 12-14 and 16

Independent claim 12 provides as follows (emphasis added):


12.    A program stored on a computer readable medium, the *program being configured to provide a client on a remote client network access to a resource on a local network*, the program comprising:

logic configured to provide a graphical user interface (GUI) to an operator with which client connectivity to the resource *on the local network* is enabled, *the GUI being configured such that the process used by the operator to facilitate connectivity using the GUI is the same regardless of a configuration of the remote client network*;

logic configured to receive commands of the operator with the GUI that convey the identity of the client and the resource to be accessed by the client;

*logic configured to automatically determine the client network configuration*; and

*logic configured to automatically establish client connectivity to the resource so as to provide the client on the remote client network access to the resource on the local network.*

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Regarding claim 12, Hansen fails to teach or suggest a "program being configured to provide a client on a remote client network access to a resource on a local network", a GUI that is "configured such that the process used by the operator to facilitate connectivity using the GUI is the same regardless of a configuration of the remote client network", "logic configured to *automatically* determine the client network configuration", or "logic configured to *automatically* establish client connectivity to the resource", for reasons described in the foregoing.

In view of the above, Applicant respectfully submits that Hansen does not anticipate claims 12-14 and 16, and requests that the rejection be withdrawn.


III.    **Claim Rejections - 35 U.S.C. § 103(a)**
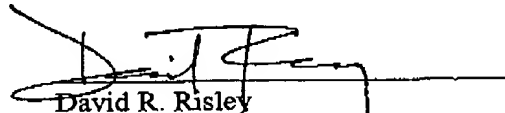
Claims 4-5, 10, and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hansen. Applicant respectfully traverses this rejection.

As is identified above in reference to independent claims 1, 7, and 12, Hansen does not teach several explicit limitations of Applicant's claims. Because of this fact, claims 4-5, 10, and 15 are allowable over Hansen for at least the same reasons that claims 1, 7, and 12 are allowable over Hansen.

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## CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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